

10400 Eaton Place
Suite 312
FAIRFAX, VA
Phone: (703) 385-5200
Fax: (703) 385-5080

KEATING & BENNETT LLP

Fax

2817


To: Examiner A. Kinhead	From: Christopher A. Bennett
Fax: 703-872-9318	Date: November 21, 2002
Phone: 703-305-3486	Pages: 9
Re: 09/731,004	CC:

•Comments:

Examiner Kinhead,

Please find attached a Request for Reconsideration and a Petition for Two-month Extension of time, along with a Credit Card form in the amount of \$400.00 for U.S. Application No. 09/731,004.

Respectfully submitted,



Christopher A. Bennett
for
KEATING & BENNETT, LLP
(Reg. No. 48,710)

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted to Group Art Unit 2817, 703-872-8318, addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231

Date: November 21, 2002

Scott V. McVean
Scott V. McVean

PATENT
36856.885

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Fumitoshi SATO	Art Unit: 2817
Serial No.: 09/731,004	Examiner: A. Kinhead
Filed: December 6, 2000	
Title: OSCILLATOR	

REQUEST FOR RECONSIDERATION**FAX RECEIVED**

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

In response to the Office Action dated July 9, 2002, the period for response to which has been extended to December 9, 2002, by the accompanying Petition for a TWO-month Extension of Time, please reconsider the above identified application in view of the following remarks.

Claims 1-14 are pending in this application.

Claims 1-8 and 12-14 were rejected under 35 U.S.C. §103(a) as being obvious over Lewis (US 5,748,051) in view of Razavi (RF Microelectronics, 1998). Claims 1-14 were rejected under 35 U.S.C. §103(a) as being obvious over Van Amesfoort (US 5,712,596) in view of Razavi (RF Microelectronics, 1998). Applicant respectfully traverses the rejections of claims 1-14.

Serial No. 09/731,004
November 21, 2002
Page 2 of 6

Claims 1, 4, and 6 recite in part:

"wherein said amplifying circuit comprises an element having a frequency characteristic, thereby decreasing power amplification of said amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$, as compared to the power amplification of said amplifying circuit at the oscillating frequency f_0 ." (emphasis added)

Applicant agrees with the Examiner that Lewis and Van Amesfoort show an oscillator in Fig. 2 and do not show an element for decreasing the power amplification of an "amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$ " which the Examiner has renamed "resonant filter," a term which does not occur in the specification or the claims of the present application.

It seems the Examiner has attempted to rely on Razavi to cure this deficiency of Lewis and Van Amesfoort, but the Examiner has failed to point out where in Razavi an element for decreasing the power amplification of an "amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$ " is taught or suggested.

Razavi only teaches a definition of Q, "Q is defined as the resonance frequency divided by the two-sided -3-dB bandwidth." Applicant does not understand how this even remotely suggests an element for decreasing the power amplification of an "amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$ " as recited in Applicant's claims 1, 4, and 6. Applicant has reviewed Lewis, Van Amesfoort, and Razavi and cannot find any teaching or suggestion for an element for decreasing the power amplification of an "amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$."

Furthermore, Razavi merely shows the definition of Q in a resonator circuit having a two-sided -3 dB range bandwidth, with a symmetrical frequency distribution as shown in Fig. 7.16 of Razavi. In contrast, in the present claimed invention, the range of



Serial No. 09/731,004

November 21, 2002

Page 3 of 6

the frequency band in which the power amplification of the amplifying circuit is reduced by at least 3 dB is a frequency range that is lower than 0.5 times an oscillating frequency f_0 or higher than about $2f_0$, which range is clearly non-symmetrical. This non-symmetrical frequency distribution where the amplification is reduced by at least 3 dB is clearly not disclosed or suggested anywhere in Razavi. The very clear differences between the prior art and the present invention can be seen by a comparison of Fig. 7.16 of Razavi and Fig. 2 of the present application.

The Examiner alleged that modifying Lewis to have an element for decreasing the power amplification of an "amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$ " would have been "well within the level of skill of one of ordinary skill in the art" (paragraph bridging pages 2 and 3 of the Office Action). The Examiner states that Razavi supports this allegation (lines 3 and 4 on page 3 of the Office Action). However, Applicant cannot find any teaching or suggestion of this allegation in Lewis or Razavi. The Examiner is reminded that an assertion that one of ordinary skill in the relevant art would have been able to arrive at Applicant's invention because he had the necessary skills to carry out the requisite process steps is an inappropriate standard for obviousness. That which is within the capabilities of one skilled in the art is not synonymous with obviousness. See Ex Parte Levengood, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993).

Also, the Examiner alleges that the use of an element in an oscillator for decreasing power amplification of an "amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$ " is "notoriously well known" (paragraph bridging pages 2 and 3 of the Office Action). The Examiner states that Razavi supports this allegation (lines 3 and 4 on page 3 of the Office Action). However, there is no teaching or suggestion of this allegation in Razavi. The Examiner is reminded that prior art rejections must be based on evidence. Graham v. John Deere Co., 383 U.S. 117 (1966). Pursuant to MPEP § 2144.03, the Examiner is hereby requested to cite a reference in support of his position that it was well known at

Serial No. 09/731,004

November 21, 2002

Page 4 of 6

the time of Applicants' invention to have an element in an oscillator for decreasing the power amplification of an "amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$." If the rejection is based on facts within the personal knowledge of the Examiner, the data should be supported as specifically as possible and the rejection must be supported by an affidavit from the Examiner, which would be subject to contradiction or explanation by affidavit of Applicants or other persons. See 37 C.F.R. §1.104(d)(2).

Furthermore, the Examiner alleged that the prior art renders obvious Applicant's claimed invention because the prior art teaches "conventional resonant elements that are designed to select a particular frequency of operation, within a 3 dB bandwidth design and the reduction of phase noise." Thus, the Examiner has clearly ignored the recitation of an element for decreasing the power amplification of an amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$, has reduced Applicant's claimed invention to the mere idea of using a 3 dB bandwidth design, and has alleged that to modify the prior art references to achieve Applicant's claimed invention would have only required an obvious matter of design choice.

The Examiner is clearly wrong on all three counts.

The Federal Circuit has held that no limitation or wording anywhere in the claim can be ignored in determining patentability. In re Stencel, 828 F.2d 751 (Fed. Cir. 1987). Thus, the Examiner MUST give patentable weight to and provide some prior art teaching or suggestion of Applicant's claimed feature of an element for decreasing the power amplification of an amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$, or allow the claims.

Furthermore, Applicant's invention must be considered "as a whole". Medtronic, Inc., v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 220 USPQ 97, 99-100 (Fed. Cir. 1983). Rather than considering the invention "as a whole," the Examiner improperly

Serial No. 09/731,004

November 21, 2002

Page 5 of 6

reduced Applicant's claimed invention to the "idea" of using a 3 dB bandwidth design. Reducing a claimed invention to an "idea" and then determining patentability of that "idea" is error. Jones v. Hardy, 727 F.2d 1524, 1528, 220 USPQ 1021, 1024 (Fed. Cir. 1984).

In addition, an obviousness rejection based on an allegation of design choice is clearly wrong and has been rejected by the U.S. Patent Office. The U.S. Patent Office Board of Patent Appeals and Interferences has concluded that a rejection on this basis is clearly improper. See In re Garrett, Appeal No. 580-81 (BPAI 1986), wherein in reversing an obviousness rejection, the Board criticized that the Examiner's statement that the proposed modification would have been an obvious matter of engineering design choice with the explanation that such an assertion is a conclusion, not a reason.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-8 and 12-14 under 35 U.S.C. §103(a) as being obvious over Lewis in view of Razavi and the rejection of claims 1-14 under 35 U.S.C. §103(a) as being obvious over Van Amesfoort in view of Razavi.

Accordingly, Applicant respectfully submits that Lewis, Van Amesfoort, or, Razavi, alone or in combination, fails to teach or suggest the unique combination and arrangement of elements recited in claims 1-14 of the present application.

In the March 4, 2002 response to the First Office, Applicants submitted arguments concerning the failure of the prior art references to teach or suggest Applicants' claimed invention including decreasing the power amplification of an amplifying circuit by at least 3 dB in a frequency band lower than about 0.5 times an oscillating frequency f_0 or higher than about $2f_0$. The Examiner failed to acknowledge or respond to these arguments. MPEP Section 707(f) requires that the Examiner specifically respond to all of Applicants' arguments. The Examiner has failed to do so. Therefore, the Examiner is respectfully requested to specifically respond to Applicants' arguments for patentability above or allow the application.

In view of the foregoing Request for Reconsideration, Applicant respectfully

Serial No. 09/731,004
November 21, 2002
Page 6 of 6

submits that claims 1-14 are allowable and that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicants petition the Commissioner for a TWO-month extension of time, extending to December 9, 2002, the period for response to the Office Action dated July 9, 2002.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: November 21, 2002


Attorneys for Applicant

Joseph R. Keating
Registration No. 37,368

Christopher A. Bennett
Registration No. 46,710

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TECHNOLOGY CENTER 2800

KEATING & BENNETT LLP
10400 Eaton Place, Suite 312
Fairfax, VA 22030
Telephone: (703) 385-5200
Facsimile: (703) 385-5080